

REMARKS

Claims 2, 3, 5 and 7 are pending in this application. By this Amendment, claims 2, 3, 5 and 7 are amended. The amendments introduce no new matter because they are supported by at least the claims as originally filed. Claims 1, 4, 6 and 8-13 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

The Office Action, on page 2 makes Final the Restriction Requirement. As such, claims 9-11 are provisionally withdrawn from further consideration. Applicants note that the Office Action applies an improper standard in asserting that Applicants' election was made without traverse. Applicants' Response to Restriction Requirement filed November 3, 2006 clearly stated that Applicants' election was being made with traverse. Further, Applicants noted that the Examiner had not established a serious burden in examining and considering the two groups of claims which were indicated as being sufficiently related. It is improper, therefore, for the Office Action to assert that Applicants' election was made without traverse. Without conceding the propriety of the Restriction Requirement, Applicants voluntarily cancel claims 9-11 as drawn to a non-elected group of claims.

The Office Action, on page 2, rejects claims 1-4 and 12 under 35 U.S.C. §102(b) as being anticipated by what the Office Action asserts is U.S. Patent No. 3,694,131 to Knaus. The Office Action, on page 3, rejects claims 5-8 and 13 again under 35 U.S.C. §102(b) as being anticipated by Knaus.

Clearly, some error is prevalent in the assertion of these two rejections because U.S. Patent No. 3,694,131 is to Stuart. Applicants presume because there is no other reference to Stuart either in any of Applicants' Forms PTO-1449 or in any attached Form PTO-892 that Stuart is not being applied as a reference to render anticipated the subject

matter of the pending claims. Rather, Applicants understand that U.S. Patent No. 5,190,706 to Knaus, which Applicants forwarded to the Patent Office in an Information Disclosure Statement filed on June 14, 2005, is the reference to which the Office Action is intended to refer. Additionally, Applicants do not understand why differing sets of claims have been broken out separately to be allegedly shown as anticipated by the same reference.

The above being stated, the rejections of the Office Action are respectfully traversed with the understanding that all references are to U.S. Patent No. 5,190,706 to Knaus.

If any of the above assumptions are incorrect, or deserve further explanation, Applicants respectfully assert that a next Office Action to issue cannot be made Final based on the facial errors in this Office Action. To expedite further prosecution of this application, however, Applicants address what they presume to be the intended rejections of the Office Action.

Knaus teaches a method for making multicolored foam that is indicated as being, for example, multidensity and/or multithermal plastic, in which heat-plastified foamable gels of a thermoplastic resin or resins containing blowing agents are combined and extruded simultaneously through the same orifice of a die and expanded into a foam (Abstract). With reference to, for example, various parts of the disclosure of Knaus, the Office Action alleges that Knaus can reasonably be considered to disclose "various modifying materials which would implicitly effect [sic] the viscosity of another material when mixed therewith." The analysis of the Office Action in this regard fails for at least the following reasons.

First, in reviewing the anticipation standard, the Federal Circuit has stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added). Additionally, other court precedent clarifies the requirements for anticipation, stating that "the

reference ... must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference."

In re Arkley, 455 F.2d 586, 587, 172 USPQ 524 (CCPA 1972); *see also Sandisk Corp. v. Lexar Media, Inc.*, 91 F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that "[u]nless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation.") and *Aero Industries Inc. v. John Donovan Enterprises-Florida Inc.*, 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that "[n]ot only must a prior patent or publication contain all of the claimed elements of the patent claim being challenged, but they 'must be arranged as in the patented device'").

This standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the . . . claim."

Further, although the same terminology need not be used, "the elements must be arranged as required by the claim."

The Office Action apparently concedes that Knaus does not explicitly teach inclusion of viscosity modifying materials. A general statement that inclusion of modifying materials may implicitly affect the viscosity of another material may be generally the case but such an unintentional or tangential effect does not render a specific reference anticipatory.

Second, as explained in MPEP §706.02, the section entitled "DISTINCTION BETWEEN 35 U.S.C. 102 AND 103," a reference used under 35 U.S.C. §102 "must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." As viscosity modifying materials are not explicitly taught by Knaus, the Office Action must be relying on a theory of inherency. However, MPEP §2112 states that the Patent Office must provide rationale or evidence tending to show inherency. Citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQd 1949, 150-51 (Fed. Cir.

1990), MPEP §2112 states, "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Additionally, citing Ex Parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), §2112 states, "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (emphasis in original).

In extrusion of high viscosity polymeric materials, excessive shear forces are generated to the melt leading to melt fracture. The tendency of polymeric materials to melt fracture, and the loss of surface smoothness, in an extrusion process therefore becomes a problem. The subject matter of the pending claims is intended to address, among other objectives, melt flow irregularities in the forming die leading to losses in product quality and production capacity. These objectives are aptly set forth in Applicants' disclosure as unexpected results achieved by the subject matter of the pending claims. Specifically introducing a viscosity modifying additive to the surface portion of the stream of extrudable material, as is varyingly recited in at least independent claims 2 and 5, is simply not taught, nor is it even suggested, by Knaus. The subject matter of the pending claims and the specific method recited therein results in an extrudable material that is changed to create less shear to the melt, for example, at the extrusion orifice, resulting in higher production speeds and improved surface quality. Such viscosity adjustment is dependent upon the extruded material and the extrusion conditions. Modifying the properties of layers for other reasons does not anticipate the subject matter of the pending claims.

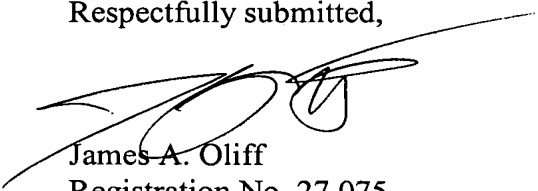
There is no disclosure in Knaus that the aforementioned objectives are even recognized. Nor is there any manner by which any disclosure of Knaus can reasonably be construed to address such objectives.

For at least the above reasons, Knaus cannot reasonably be considered to teach, or to have suggested, the combinations of all of the features positively recited in independent claims 2 and 5. Further, claims 3 and 7 are also neither taught, nor would they have been suggested, by Knaus for at least the respective dependence of these claims directly on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 2, 3, 5 and 7 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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